REMARKS

Claims 32-38 and 43-47 are pending in this application, of which Applicant amends claims 32 and 43.

Claim Amendments

Applicant amends claims 32 and 43 to more appropriately define the claimed subject matter. These amendments do not add any new subject matter.

103(a) Rejection of Claims 32-35 and 43-46

The Examiner rejected claims 32-35 and 43-46 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,768,164 to Hollon, Jr. ("*Hollon*") in view of U.S. Patent No. 6,633,930 to Sonehara et al. ("*Sonehara et al.*"). Applicant respectfully traverses this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness under § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Moreover, both of these requirements must be found in the prior art, not in applicant's disclosure. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143 (8th ed., Rev. 4, October 2005).

Applicant respectfully traverses the Examiner's rejection of claims 32-35 and 43-46, as unpatentable over *Hollon* in view of *Sonehara et al.*, at least because these references, alone or in combination, fail to teach or suggest each and every element of independent claim 32, from which claims 33-35 depend, and these references also fail to teach or suggest each and every element of independent claim 43, from which claims 44-46 depend. For example, *Hollon* fails to teach or suggest a "main display," a "sub-display provided … at a position where the sub-display is externally visible when the main display is in a closed position," and either

> "a jog device that is operated to (i) **select an application program** and (ii) **start the selected application program in one of a power-off state, a sleeping state, and a main display off state**; and
> display control means that **displays** on the sub-display, **in the power-off state, sleeping state, or main display off state, a start menu comprising a name of the application program to be selected and started**," as recited in claim 32 (emphasis added); or

> "detecting an operation of the jog device to (i) **select an application program** and (ii) **start the selected application program in one of a power-off state, a sleeping state, and a main display off state**; and
> **displaying, in the power-off state, sleeping state, or main display off state, a start menu comprising a name of the application program to be selected and started**," as recited in claim 43 (emphasis added).

Hollon teaches, "[w]hen a user of portable computer 10 desires to utilize a particular application program on spontaneous use display 39, the user locates the active window of the application program at section 21 of display 20 (shown in FIG. 1). The user then puts portable computer 10 into an inactive mode and closes the cover." (Col. 2, line 65 to col. 3, line 3; emphasis added.) "Spontaneous use function keys 31 through 38 are respectively mapped to the functionality of function keys 11 through 18" (col. 2, lines 62-64). After portable computer (10) has been put into the inactive mode

and the cover has been closed, "[p]ressing any of spontaneous use function keys 31 through 38 activates spontaneous use display 39" (col. 3, lines 3-5).

The Examiner argues that "Hollon teaches a device which starts an application program in one of a power-off state, a sleeping state, and a main display off state" at Figures 2-7 and column 3, lines 1-17 (Office Action, pg. 5, paragraph 5). However, the Examiner appears to misconstrue *Hollon*, which teaches that the application program is started <u>before</u> the user puts portable computer 10 into the inactive mode and closes the cover. Once the user presses spontaneous use function keys (31-38) to activate spontaneous use display (39), the application program has <u>already</u> been started.

Spontaneous use function keys (31-38), which are pressed to activate spontaneous use display (39) in *Hollon*, do not "<u>select</u>" and "<u>start</u>" an application program "in one of a power-off state, a sleeping state, and a main display off state," as required by amended claims 32 and 43 (emphasis added). Moreover, the application program of *Hollon* must <u>already have been started</u> in the active window <u>before</u> the application program can be utilized on the spontaneous use display (39). Spontaneous use display (39) of *Hollon* can only be activated in regard to an application <u>after</u> that application has been started in an active mode with the cover open. Thus, when the application program of *Hollon* is started, portable computer (10) is in an <u>active mode</u>, and with the cover opened, which does not constitute "one of a power-off state, a sleeping state, and a main display off state," as required by claims 32 and 43.

The Examiner further argues that the window (for the phone book application) shown in Figure 5 of *Hollon*, or the window (for the CD player application) shown in

Figure 7 of *Hollon*, constitutes "a name of an application program to be started," as required by claims 32 and 43 (Office Action, pg. 6, paragraph 1). However, the windows shown in Figures 5 and 7 are for applications that <u>have already been started</u>. Displaying a window for an application <u>that is currently running</u> does not constitute displaying "<u>a start menu comprising a name</u>" of an application program that is "<u>to be selected and started</u>," as required by amended claims 32 and 43 (emphasis added).

Sonehara et al. does not make up for the deficiencies of *Hollon* because *Sonehara et al.* only discloses a jog device and its associated hardware and software. *Sonehara et al.* also fails to teach or suggest either of the limitations of operating a jog device to "(i) select an application program and (ii) start the selected application program in one of a power-off state, a sleeping state, and a main display off state," or displaying "in the power-off state, sleeping state, or main display off state, a start menu comprising a name of the application program to be selected and started," as recited in amended claims 32 and 43.

Thus, since *Hollon* and *Sonehara et al.*, taken alone or in combination, do not teach or suggest each and every element of independent claim 32 or independent claim 43, claims 32 and 43, and claims 33-35 and 44-46 dependent therefrom, respectively, are allowable over *Hollon* and *Sonehara et al.*

103(a) Rejection of Claims 36-38 and 47

The Examiner also rejected claims 36-38 and 47 under 35 U.S.C. § 103(a) as unpatentable over *Hollon*, *Sonehara et al.*, and *Mondshine et al.* Applicant respectfully

traverses this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

Claims 36-38 and 47 are allowable over *Hollon*, *Sonehara et al.*, and *Mondshine et al.* for at least the reason that these claims depend from claims 32 and 43, respectively, which are allowable over *Hollon* and *Sonehara et al.* for the reasons explained above. *Mondshine et al.* fails to make up for the deficiencies of *Hollon* and *Sonehara et al.* because *Mondshine et al.* also does not teach or suggest either of the limitations of operating a jog device to "(i) select an application program and (ii) start the selected application program in one of a power-off state, a sleeping state, and a main display off state," or displaying "in the power-off state, sleeping state, or main display off state, a start menu comprising a name of the application program to be selected and started," as recited in amended claims 32 and 43.
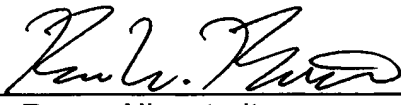
CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge

any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: September 27, 2006   By: _____

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